



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/127,059	07/31/1998	AMEDEO LEONARDI	648/1D340-US	9662

7590 07/25/2002
ROBERT C SULLIVAN
DARBY & DARBY
805 THIRD AVENUE
NEW YORK, NY 10022

EXAMINER

BERNHARDT, EMILY B


ART UNIT	PAPER NUMBER
----------	--------------

1624

DATE MAILED: 07/25/2002

26

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/127,059	Applicant(s) LEONARDI et al.	
	Examiner Emily Bernhardt	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 4/29/02.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-21 is/are pending in the application.

4a) Of the above, claim(s) 6-18 is/are withdrawn from consideration.

5) ☒ Claim(s) 21 is/are allowed.

6) ☒ Claim(s) 1, 2, 4, and 5 is/are rejected.

7) ☒ Claim(s) 3, 19, and 20 is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
~~If approved, corrected drawings are required in reply to this Office action.~~

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____	6) <input type="checkbox"/> Other:

Art Unit: 1624

In view of applicants' response filed 4/29/02 the following applies.

Claims 1,2,4 and 5 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Nature of fused B rings remain obscure. The new terminology recites "aromatic ring" without identifying the nature of the ring members. Note In re Wiggins cited in previous actions. Additionally the claim language includes optional substituents N,O or S which makes applicants' intent even further unclear since these atoms as "substituents" i.e. monovalent moieties are incomplete as additional groups/atoms are needed to fulfill valency requirements.

Claims 1,2,4 and 5 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The new terminology for fused B rings is new matter as it lacks descriptive support in the disclosure as originally filed. The section in the specification applicants rely on for support is referring to the definition of "heteroaryl" wherever the term

Art Unit: 1624

appears. However said term has long been cancelled by applicants. See Amendment filed 11/26/99 and applicants' remark made on p.6 of that amendment. This aside the definition in specification for heteroaryl is not the same as the one now being claimed which includes any aromatic ring and any N-,O-,S-containing substituent. Also the new terminology would exclude the very example (eg.2) applicants rely on for its support. Note that dioxane is not aromatic.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,2,4 and 5 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota for reasons of record. Applicants urge they are entitled to benefit under 35 USC 119 of earlier foreign application which precedes Shiota.

However, applicants cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Claims 1,2,4 and 5 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Janssen for reasons of record. The traverse to this rejection is not persuasive for the following reasons. Where claimed compounds are so similar in

Art Unit: 1624

structure to prior art compounds, sufficient motivation does exist to make the claimed compounds with the expectation that they will have similar properties. Note MPEP 2144.09,p.2100-147,first paragraph, Rev. August 2001 which cites decisions such as In re Payne 203 USPQ 245 for legal authority in determining obviousness based on close structural similarity. While Wood and Lohr previously cited dealt with a similar utility for prior art and claimed compounds, it was the closeness in structural similarity between prior art and claimed compounds that was stressed by the Court in affirming the PTO. Such rationale was also applied in earlier decisions involving H vs. Me (or 2Me's). See Ex parte Henkel 130 USPQ 474 and Ex parte Fauque 121 USPQ 425 in which a similar utility issue was never even a

consideration. Also note In re Shetty 195 USPQ 753 in which claimed ethylene derivatives were held obvious over corresponding prior art methylene derivatives which had a completely different utility. Note in all these cases the applied references did not teach the structural alterations needed that would result in the compounds/compositions on appeal and yet claims were still refused. Also see In re Dillon 16 USPQ 2d 1897 which cites Shetty with approval and has expressly

Art Unit: 1624

overruled In re Wright (6 USPQ 2d 1959), a case that employed the same rationale as the decisions cited by applicants on p.10 of their response.

Claims 3,19 and 20 remain objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 21 is allowed.

This application contains claims 6-18 drawn to an invention nonelected with traverse in Paper No. 8. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

~~Any inquiry concerning this communication should be directed to Emily~~

Bernhardt at telephone number (703) 308-4714.

A facsimile center has been established for Group 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or (703) 305-3592.

Application/Control Number: 09/127059

Page 6

Art Unit: 1624

E Bernhardt
EMILY BERNHARDT

PRIMARY EXAMINER

GROUP 1600
